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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,141	11/19/2003	Kyoko Iwamoto	03697/HG	7263

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
767 THIRD AVENUE
25TH FLOOR
NEW YORK, NY 10017-2023

EXAMINER

KLEMANSKI, HELENE G

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/717,141	IWAMOTO ET AL.	
	Examiner	Art Unit	
	Helene Klemanski	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/15/03</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: on page 5, line 20 of the specification, the term "-NHCOOr₄" should be replaced with the term "-NHCOOR₄".

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-14 and 18-20 of copending Application No. 10/437,660 (US 2003/0230216). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

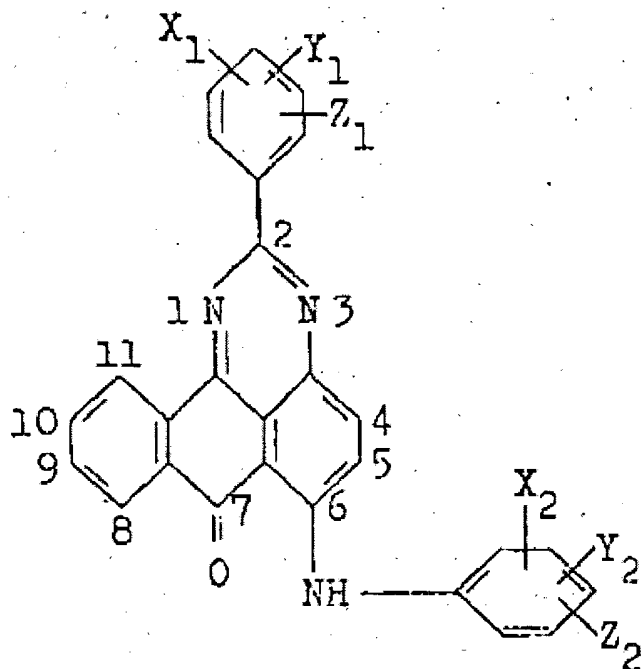
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Wick.

Wick teaches an anthrapyrimidine dye compound of the formula



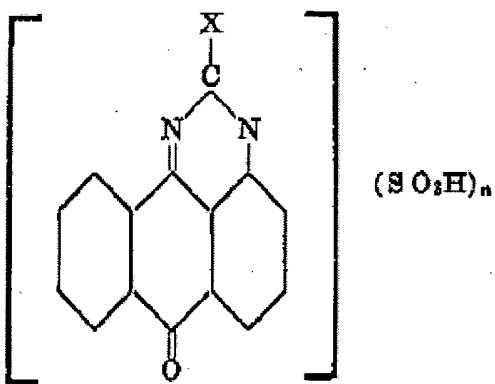
wherein X₁ is hydrogen (i.e. hydrogen bonding group); Y₁ and Z₁ are hydrogen, halogen or alkyl (i.e. substituent); X₂ is hydrogen, halogen, alkyl, alkoxy, phenyl,

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phenylsulphonyl, phenoxy, phenylamino, benzoylamino or nitrile group (i.e. substituent) and Y_2 and Z_2 are hydrogen, halogen or alkyl (i.e. substituent). See col.1, line 5 – col. 2, line 15 and claims 1-3. The anthrapyrimidine dye compound as taught by Wick appears to anticipate the present claims.

6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Koeberle et al.

Koeberle et al. teach an anthrapyrimidine dye compound of the formula



wherein n is from 0-3 and X is arylamino (i.e. hydrogen bonding group). See claim 5.

The anthrapyrimidine dye compound as taught by Koeberle et al. appears to anticipate the present claims.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

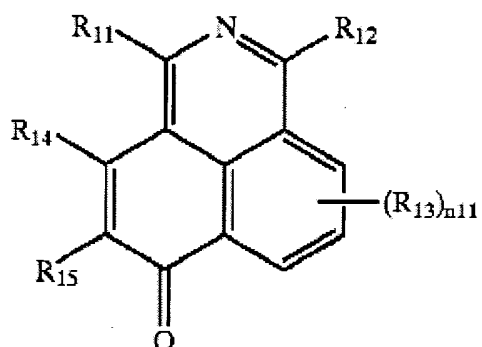
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 1-13 are rejected under 35 U.S.C. 103(a) as being obvious over Iwamoto et al. (US 2003/0230216).

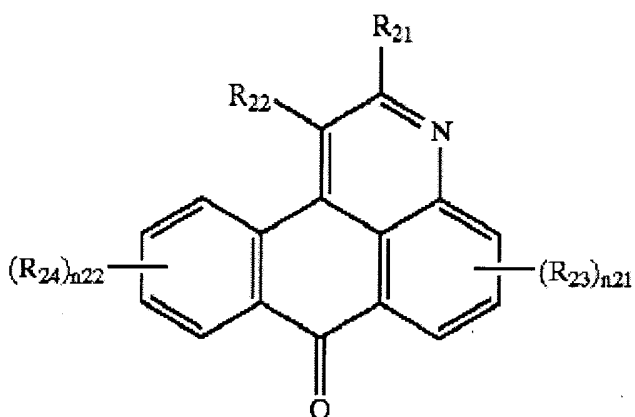
The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Iwamoto et al. teach an ink jet recording liquid comprising a dye of the formula
(1)

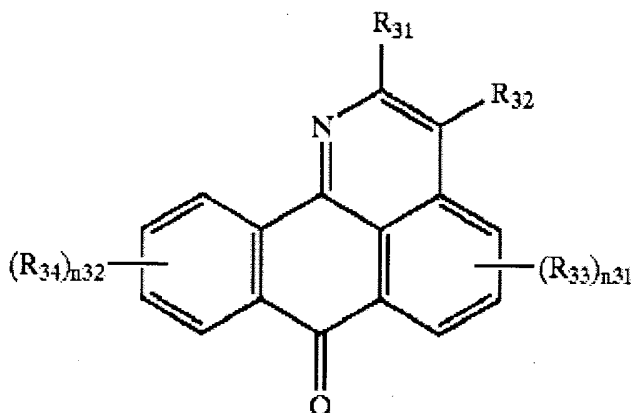
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wherein R₁₁-R₁₅ are H or a substituent; R₁₄ and R₁₅ may be bonded to form an aromatic ring and n₁₁ is an integer of 1-3 or a dye of the formula (2)



wherein R₂₁-R₂₄ are H or a substituent; n₂₁ is an integer of 1-3 and n₂₂ is an integer of 1-2 or a dye of the formula (3)



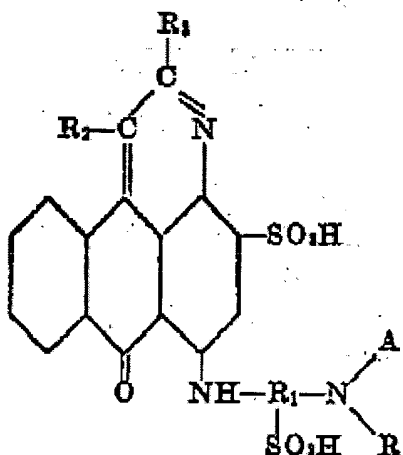
wherein R₃₁-R₃₄ are H or a substituent; n₃₁ is an integer of 1-3 and n₃₂ is an integer of 1-4 and a solvent. The substituent is not particularly limited and can be alkyl, aryl, aryloxy, sulfonyl etc. The solvent can be a water-based solvent, an oil-based solvent or a solid solvent. When the solvent is water-based, it is preferable that the dye contain at least one sulfonate group or at least one carboxyl group. When the dye is insoluble in the water-based solvent, it is preferable to disperse the dye in the water-based solvent with an oil-soluble polymer as a fine particle dispersion. See paras. 0012-0032, dye formula (2-27), paras. 0061-0067, examples 1-3 and claims 1-14 and 18-20. Iwamoto et al. fails to specifically exemplify the use of a dye of the above formulas wherein the substituent is a substituted phenyl group as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific dye of the above formulas wherein the substituent is a substituted phenyl group as claimed by applicants as Iwamoto et al. also discloses the use of these dyes but fails to show an example incorporating them.

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9. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.
10. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guenthard.

Guenthard teaches a dye of the formula



wherein R₁ is a phenylene; R is a halogeno acetyl radical, halogeno propionyl radical or halogen substituted triazine radical (i.e. substituent); A is H or alkyl; R₂ is a carboxyalkyl radical, alkylcarbonyl or phenylcarbonyl radical (i.e. substituent) and R₃ is a phenyl that may be substituted. See col. 3, lines 15-62, examples 5, 6, 14, 15, 17 and 31 and claim 5. Guenthard fails to specifically exemplify the use of a dye of the above formulas wherein the substituent is a substituted phenyl group as claimed by applicants.

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Therefore, it would have been obvious to one having ordinary skill in the art to use the specific dye of the above formulas wherein the substituent is a substituted phenyl group as claimed by applicants as Guenthard also discloses the use of these dyes but fails to show an example incorporating them.

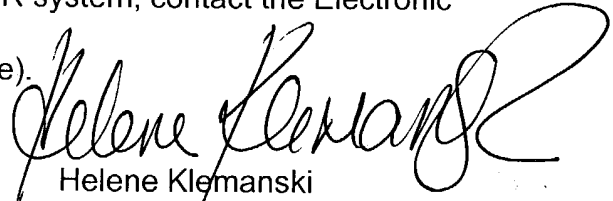
Conclusion


The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Helene Klemanski
Primary Examiner
Art Unit 1755


HK
October 18, 2004